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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/709,871	06/02/2004	Michael Zimmermann	LVIP112US	3870
24041	7590	08/10/2006	EXAMINER	
SIMPSON & SIMPSON, PLLC 5555 MAIN STREET WILLIAMSVILLE, NY 14221-5406				MICHALSKI, SEAN M
ART UNIT		PAPER NUMBER		
				3724

DATE MAILED: 08/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/709,871	ZIMMERMANN ET AL.
	Examiner Sean M. Michalski	Art Unit 3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 02 June 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-12 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 02 June 2004 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>10/29, 11/02, 2004</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Germany on June 7th 2003. It is noted, however, that applicant has not filed a certified copy of the 103 25 944.9 application as required by 35 U.S.C. 119(b).

Drawings

2. Figures showing the prior art are usually unnecessary and should be cancelled from the application. See MPEP § 608.02(g).

3. Figure 1 should be designated by the legend --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "22" has been used to designate both the knife blade of the present invention and the knife blade of the prior art. They are on different devices and are not the same element, even though they are both knives. Similar is true of element "10" used to refer to distinct stereomicroscopes. Corrected drawing sheets in

compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the drawings are blurry and it is difficult to discern one component from another. The figures are not clear. The arrows are not neat enough to point out essential subject matter that is being described in the specification. Applicant is advised to employ the services of a competent patent draftsperson outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

6. The drawings are objected to under 37 CFR 1.83(a) because they fail to show "the rigid guide" as described in [0028] of the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures

appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 2-5 and 10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The positioning of the detents, and their interaction with the pivoting device,

critical or essential to the practice of the invention, was not discussed in the specification or shown clearly in the drawings, or described in enough detail in the claims to enable one of ordinary skill in the art to make the claimed invention or use the claimed method.

9. Claims 2-5 and 10 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure that is not enabling. The "rigid guide", critical or essential to the practice of the invention, is not included in the claim(s) and is not referenced in the drawings. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The "rigid guide" is essential to the understanding of the detent system, but is not referenced in the drawings or put forth in the claims. One of ordinary skill in the art, therefore, would not be capable of making or using the invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a

question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims 1 and 9 recite the broad recitation a “cutting apparatus”, and the claim also recites “a microtome” which is the narrower statement of the range/limitation.

11. In the present instance, claims 1 and 9 recite the broad recitation “an observation device”, and the claim also recites “a stereo microscope” which is the narrower statement of the range/limitation.

12. In the present instance, claim 6 recites the broad recitation “position marking”, and the claim also recites “scale” which is the narrower statement of the range/limitation.

13. Claim 5 recites the limitation, “a rotary knob that comprises the detent element”, which is not clear in identifying how the rotary knob *comprises* a detent element. The relationship between the rotary knob and detent element are unknown. This limitation will be treated on the merits, as best understood by the Examiner.

Claim Rejections - 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. Claims 1, 9 and 12, are rejected under 35 U.S.C. 102(b) as being anticipated by Persson'844 (USPN 3,103,844).

16. Regarding claims 1, 9 and 12, Persson'844 discloses a microtome (only figure) comprising a stereomicroscope (11) and pivoting device (10) and a positioning device (9) which positions the pivoting device. The apparatus as set forth is capable of performing all the functions required by the claim. The method of claims 9 and 12 recites that the elements above must be 'provided'; by their very presence they have been 'provided'. The step of pivoting is anticipated by column 2 line 23. It is noted that any angle the pivot moves to is 'defined', at least since all the angles are measurable.

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.

3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

19. Claim 2 –5 7, 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Persson'844 (USPN 3,103,844) in view of Blum (USPN 3,908,878). Regarding claim 2, Persson'844 does not disclose a detent fixture associated with the positioning device.

Blum discloses that "Ball 303 cooperates with any one of a plurality of circumferentially spaced indexing recesses 306, 307 and 308, formed in the surface of selector shaft 288. By this means, shaft 288 may be rotated by manual operation of knob 291 to position said shaft in any selected one of several indexed locations". This shows that detent indexing for rotating surfaces is known in the microtome art. The 'indexed locations' provide the shaft with defined angles.

In the same field of invention it would have been obvious to one skilled in the art at the time of the invention to modify Persson'844 by adding detent indexing to element 9 and 10 as taught by Blum. The motivation to combine is that indexing is an old and well known method of providing predetermined relative angle positioning (see Blum).

Regarding claim.

20. Regarding claim 3, as with all ball and socket detent indexing devices, in Persson'844 in view of Blum the ball is repositioned from one to the other hole. While it is moved between detent holes, it is between the detent holes; therefore it is possible to position it between the holes.

21. Regarding claim 4, in Persson'844 in view of Blum, there are three recesses (detent grooves) on a pivot element (the pivot 9 of Persson).
22. Regarding claim 5, in Persson'844 in view of Blum, there is a rotary knob (291) that interacts with the detent elements and is provided for its control. Since the knob effects the changing of the detent position, it would be provided along with the detent structure in the combination of Persson'844 in view of Blum.
23. Regarding claim 7, the detent system of Persson'844 in view of Blum is a position storage device, since it allows for reproduction of the same angles.
24. Regarding claim 8, each element thereof has been addressed by Persson'844 in view of Blum as directed to claims 2-5 above.
25. Regarding claim 10, when pivoting occurs in the Persson'844 in view of Blum combination, the pivoting is "to defined detent positions" since there are defined detent portions as in claim 2, treated above.
26. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Persson'844 in view of Persson'578 (USPN 3,405,578).

Persson'844 discloses the microtome of claim 1, as discussed above.

Persson'844 does not explicitly disclose that the positioning device includes a scale.

Persson'578 discloses a microtome having a scale (11 figure 2) indicating the position of a microscope in relation to the cutting edge of the blade.

In the same field of invention it would have been obvious to one skilled in the art at the time of the invention to modify Persson'844 by providing the rotating microtome

microscope with a scale as taught by Persson'578. The motivation to combine is that providing a scale allows the user to examine the quality of the knife.

27. Regarding claim 11, whenever the arm of Persson'844 in view of Persson'578 is moved, pivoting is accomplished to a defined position marking (see 11, of Persson'578); refer to column 2 lines 20-30.

Conclusion

28. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lihl; Rahveed; Temple et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean M. Michalski whose telephone number is 571-272-6752. The examiner can normally be reached on M-F 7:30AM - 3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


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